REMARKS

Status Summary

Claims 38-51 and 53-62 are pending and were examined. Claims 38-51 and 53-62 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 38, 47, 50-51, and 55-56 are amended. Claims 39-41, 46, 48-49, and 60-62 are canceled. New claims 62-63 are added. A substitute sequence listing, including a paper copy and a computer-readable copy, and the requisite statement pursuant to 37 C.F.R. 1.821(f) are submitted herewith. Reconsideration in view of the claim amendments and following remarks is respectfully requested.

Rejection of Claims Under 35 U.S.C. § 112, First Paragraph

Claims 38-51 and 53-62 are rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is the examiner's opinion that the claimed methods employing anti-human CD23 monoclonal antibodies that compete with antibodies having the disclosed 5E8 and 6G5 CDRs constitutes new matter. Official action, page 2, item 4. This rejection is respectfully traversed.

The originally filed specification expressly states that "the invention embraces human monoclonal antibodies which compete with the primate anti-human CD23 monoclonal antibodies 5E8 and 6G5 for binding to CD23" (page 21, lines 19-21). Despite acknowledgment of the cited language, the examiner states that the specification does not disclose any antibodies that compete with the disclosed 5E8 and 6G5 anti-human CD23 antibodies. It appears that the examiner contests the language on the basis that examples of competitive antibodies are not included in the examples.

Applicants respond that antibodies which compete with the disclosed anti-human CD23 antibodies can be readily prepared using routine techniques for use in the claimed methods based on a review of the instant application. The specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will

be able to practice the invention without undue experimentation. *In re Borkowski*, 422 F.2d 904, 908, 164 USPQ 321, 325 (CCPA 1970). *See also* MPRE § 2164.02.

Notwithstanding the foregoing, claims 38, 47, 50-51, and 55-56 are amended to remove reference to antibodies that compete with the disclosed antibodies having CDRs of the 5E8 or 6G5 anti-human CD23 antibodies. These amendments are made to facilitate allowance of claims and should not be construed as or used as evidence of agreement with the examiner's position. Based on the amendments, claims 39-41, 46, 48-49, and 60-62 are canceled without prejudice.

In view of the claim amendments and cancellations, it is believed that the examiner's rejection of claims as allegedly containing new matter is rendered moot. Withdrawal of the rejection of claims under 35 U.S.C. § 112, first paragraph, is respectfully requested.

Substitute Sequence Listing

A substitute sequence listing, including a paper copy and a computer-readable copy, and the requisite statement pursuant to 37 C.F.R. 1.821(f) are submitted herewith. The substitute sequence listing is submitted to correctly identify the origin of SEQ ID NOs:1-8 as "artificial" in that the sequences include primate antibody variable region sequences as well as a leader sequence to facilitate cloning. The sequences were previously labeled as derived from "human." In addition, the description of sequence features of SEQ ID NOs:1-8 is amended to identify the leader sequence, which was previously referred to as a "signal peptide." Given the art-recognized meaning of the latter term, the initial region of each of SEQ ID NOs:1-8 is more accurately referred to as "leader sequence," as used in the originally filed specification (*see* pages 54-62). No new matter is added.

The specification is amended to insert the instant sequence listing in place of the previously filed sequence listing. The use of sequence identifiers in the specification is unchanged.

Discussion of New Claims

New claims 62-63 are added, which are directed to methods employing antibodies having the CDRs of antibody 5E8 (claim 62) or antibody 6G5 (claim 63). New claims 62-63 depend from claim 38 and are fully supported by the subject matter of claim 38. No new matter is added.

Conclusion

All rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and a notice to that effect is earnestly solicited. If any points remain in issue, which the examiner feels may be best resolved through a personal or telephone interview, he is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,
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